

**REMARKS**

**I. Status of Claims**

Claims 140-146 are currently pending. By this amendment, claims 140 and 146 have been amended, claims 141-143 have been canceled, and new claim 154 has been added.

Support for new claim 154, reciting at least one polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer, can be found in the originally-filed specification, for example at page 15, line 23 to page 16, line 5. This paragraph recites Uniclear<sup>®</sup> and that Uniclear<sup>®</sup> is “a blend of copolymer[s] of a C<sub>36</sub> diacid condensed with ethylene-diamine . . . .” See also International Cosmetic Ingredient Dictionary and Handbook (“CTFA”) pages 657-58 (attached herewith as Exhibit 1), reciting that ethylenediamine/stearyl dimer dilinoleate copolymer is at least one copolymer of ethylenediamine and stearyl dimer dilinoleate monomers, and further reciting that a trade name for ethylenediamine/stearyl dimer dilinoleate copolymer is Uniclear<sup>®</sup>. Thus, the specification reasonably conveys a lipstick comprising at least one ethylenediamine/stearyl dimer dilinoleate copolymer.

Support for the amendment to claim 140, wherein R<sup>3</sup>, which are identical or different, are each chosen from C<sub>2</sub> to C<sub>36</sub> hydrocarbon-based groups, can be found in the originally-filed specification, for example on page 15, lines 2-3. Support for the amendments to claims 140 and 146, reciting isododecane, can be found in the originally-filed specification, for example on page 26, lines 25 to 26, mentioning the use of isododecane as a volatile solvent. See also page 24, line 6, mentioning the use of isododecane as an oil.

## II. Rejections under 35 U.S.C. § 112

A. Claims 143 and 144 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly containing new matter. The Examiner asserts that "[t]here is no support in the specification for [the phrase] wherein said mascara further comprises PVP." Office Action at 2. While claim 143 has been canceled herein, Applicant respectfully traverses the rejection as it pertains to claim 144.

As the Examiner admits, the instant specification explicitly recites "vinylpyrrolidone copolymer." The Examiner then states that "[v]inylpyrrolidone copolymer is formed from vinylpyrrolidone monomer [and] another monomer . . . which polymerizes with the vinylpyrrolidone, whereas PVP polymer is forme[d] from vinylpyrrolidone monomer only." Office Action at 2. Thus, the Examiner concludes that the language "further comprises PVP" adds new matter.

Applicant disagrees. The specification on pages 33-34 explicitly discloses PVP: "Mention may be made, as examples of VP copolymer[s] which can be used in the invention, of . . . butylated polyvinylpyrrolidone (PVP)." Specification at page 33, lines 19-25. The specification goes on to state that, "[p]referably . . . use is made of the PVP/hexadecene copolymer . . . or the PVP/eicosene . . . ." *Id.* at page 33, line 26 to page 34, line 3. This disclosure reasonably conveys PVP to those of ordinary skill in the art. Therefore, Applicant respectfully requests reconsideration of this rejection.

B. Claims 141 and 142 have been rejected under 35 U.S.C. § 112, second paragraph. According to the Examiner, "[t]he claims recite one compound and yet the claims are in Markush group format. Deletion of 'chosen from' is suggested to

overcome the above rejection.” Office Action at 3. Claims 141 and 142 have been canceled, thus mooted this rejection.

As regards new claim 154, which has similar language to canceled claim 142 but is directed towards a different copolymer, Applicant respectfully asserts that the language “chosen from” is not indefinite, because claim 154 covers a copolymer subgenus. Essentially the same language pertaining to a similar copolymer, “at least one polyamide polymer chosen from ethylenediamine/stearyl dimer tallate copolymer,” appears in claims 1 and 3 of U.S. Patent No. 6,716,420 B2, recently issued on April 6, 2004. In those patent claims, as well as claim 154 of the present application, “copolymer” is properly used in the singular because the term is generic, covering both a single copolymer and more than one copolymer.

The specification reasonably conveys the claimed subgenus covering both a single copolymer and more than one copolymer. The specification discloses that “generally” the polymers are in the form of blends or mixtures, clearly indicating that a single polymer is also contemplated. Specification at page 15, lines 17-22. Hence, “at least one polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer,” as set forth in claim 154, defines a subgenus covering a single polymer and more than one copolymer. For at least those reasons, Applicant respectfully requests withdrawal of the rejection.

#### **IV. Rejection under 35 U.S.C. § 103**

Claims 140-142, 145, and 146 have been rejected under 35 U.S.C. § 103 over the combination of U.S. Patent Nos. 5,783,657 to Pavlin et al. (“Pavlin”) and 6,214,329 to Brieva et al. (“Brieva”). According to the Examiner, Pavlin teaches the specific

polymer, as well as combining this polymer with certain claimed additives. Office Action at 4. The Examiner admits, however, that Pavlin “does not teach the specific volatile solvent or preservatives,”<sup>1</sup> yet states that it would have been obvious to combine the specific volatile solvents taught in Brieva. *Id.* at 5. The Examiner then concludes that “[o]ne of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that . . . when this polymer is combined with isododecane, a hydrocarbon, it gives the formulation a gel-like structure.” *Id.* Applicant respectfully traverses on the ground that no *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the Examiner must, among other things, establish some motivation or suggestion to combine the references. M.P.E.P. § 2143. This the Examiner has not done.

The Examiner admits that Pavlin “does not teach the specific volatile solvent” of isododecane, as claimed in all of the instant claims, as amended. Thus, the Examiner looks to Brieva as teaching, among other things, isododecane. According to the Examiner, “[t]he motivation to combine the ingredients flows logically [from] the art for having been used in the same [m]ascara art.” Office Action at 5.

Yet Brieva explicitly teaches away from incorporating a polyamide gelling agent, such as that disclosed in Pavlin, into the composition. “It is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145

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<sup>1</sup> Applicant points out that while Pavlin does not explicitly teach preservatives, it incorporates by reference U.S. Patent No. 4,278,658 to Hooper et al., which discloses in a long list of optional ingredients that preservatives may be added to the deodorant composition disclosed therein. In this regard, Applicant submits in the Information Disclosure Statement and Form PTO 1449 filed herewith the December 23, 2004 Office Action of Examiner Tae Yoon in Application Serial No. 09/733,898.

X.2. Brieva, in fact, stresses throughout the disclosure that the composition includes a “**non-polymeric** gelling agent.” See Brieva, *passim* (emphasis added). The polyamide of Pavlin is, by definition, polymeric, and thus outside the scope of Brieva’s teachings.

Moreover, almost a year elapsed between Pavlin’s issuance and the filing of Brieva. Therefore, the polyamide of Pavlin was known in the art at the time Brieva was filed, yet Brieva still explicitly excluded that which was known in favor of a non-polymeric gelling agent. Applicant therefore fails to understand how the Examiner can maintain that one of ordinary skill in the art would be motivated to combine the polyamide polymer of Pavlin with inert fillers and/or other ingredients of Brieva, a reference that goes to great length to emphasize that the gelling agent incorporated therein is non-polymeric.

Not only does Brieva fail to suggest any motivation to combine Brieva with Pavlin, but Pavlin likewise contains no suggestion or motivation to combine the polyamide disclosed therein with the volatile solvent of Brieva. While Pavlin does teach a volatile solvent, it does so only as a **non-preferred** embodiment. “Preferably, the hydrocarbon has a relatively high number of carbon atoms, e.g., 10 to 30 carbon atoms, and **thus is not a volatile hydrocarbon.**” Pavlin, col. 15, lines 23-25. As there is no suggestion or motivation to combine Pavlin and Brieva for at least the above-mentioned reasons, Applicant respectfully requests withdrawal of this rejection, and reconsideration of the pending claims, as amended.

**V. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and continued examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 19, 2004

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**Attachment:** Exhibit 1 - International Cosmetic Ingredient Dictionary and Handbook ("CTFA") pages 657-58